

**UNITED STATES PATENT AND TRADEMARK OFFICE**  
**Before the Board of Patent Appeals and Interferences**

In re Patent Application of

Conf. No.: 7751

SEYDOUX

Atty. Ref.: SCS -677-38

Serial No. 10/585,866

TC/A.U.: 2173

Filed: July 11, 2006

Examiner: D. Bonshock

For: A VOICE INTERFACE FOR FINDING AND SELECTING AN  
OPTION, IN PARTICULAR FOR A MOBILE TELEPHONE ON  
BOARD A VEHICLE

\* \* \* \* \*

February 22, 2011

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**REPLY BRIEF**

This Reply Brief is responsive to the Examiner's Answer mailed December 20, 2010 in the above-identified appeal, the date of response to which is February 22, 2010 (February 20 falling on a Sunday and February 21 falling on a Federal holiday).

Upon review of the Examiner's Answer, it would appear that for the most part (between pages 1-10), the Answer is a restatement of the bases of rejection set out in the outstanding Final Rejection and therefore the Appeal Brief as previously filed fully responds to these arguments.

However, beginning on page 10 and continuing to page 15 of the Answer, the Examiner purportedly responds to the Appeal Brief and raises new points of argument and those will be responded to under the Appeal Brief headings as follows.

**A. The Examiner fails to properly construe Appellant's independent claims as required by 35 USC §112 (6<sup>th</sup> paragraph)**

As noted in the Appeal Brief, Appellant believes the Examiner has failed to properly apply the 6<sup>th</sup> paragraph of 35 USC §112 in interpreting the claimed “acoustic means.”

In the paragraph bridging pages 10 and 11 of the Examiner's Answer, the Examiner states that “the claim, as interpreted by the examiner, pertains to a system in which an acoustic means for providing an audible message constituting a voice representation of a selected option (as is defined via the specification) [sic].” However, the Examiner does not identify how or why he omits the required claim construction of the recited “acoustic means” in accordance with the 6<sup>th</sup> paragraph of §112 (“such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.”).

The Examiner fails to indicate the portion of Appellant's specification to which the “acoustic means” corresponds nor does he dispute Appellant's annotated claim 1 in the paragraph bridging pages 3 and 4 of the Appeal Brief which is identified as covering “transducer 20” and other elements.

The failure to follow the statutory requirements of claim construction comprises reversible error.

Furthermore, beginning on page 12 of the Examiner's Answer, the Examiner states that he believes that “Appellant's specification only defines the acoustic means as ‘means suitable for sending to the user an audible message constituting a voiced

representation of the option selected by the pointer in response to said pointer being incremented or decremented.” However, the Examiner’s attention is directed to the Appellant’s specification between pages 4 and 5 in which the “acoustic means” includes “circuit 22 receiving as an input via a contactor 24 information about the knob 14 being moved.” (Page 4, lines 27-30). The further description of the “acoustic means” is set out beginning on page 5, line 35 and continuing to page 6, line 17, and describes that the knob 14 is incremented or decremented and “the corresponding menu item . . . is then voiced by a voice synthesis device in the form of an acoustic message that is played back via the transducer 20.” (Page 6, lines 5-8). If the knob is incremented or decremented, then the next item menu is voiced (page 6, lines 20-25). If the voiced item in the menu is the correct item, then “pressing on the knob 14” chooses that menu item (page 6, lines 31-36).

Accordingly, Applicants’ specification clearly identifies structure, i.e., contactor 24, circuit 22, knob 14 and transducer 20, which comprises the claimed “acoustic means.” Instead of identifying where these structures corresponding to the “acoustic means” recitation in the claim, are disclosed in any prior art reference, the Examiner improperly parses the “acoustic means” representation into two separate functional features, i.e., “Potters teaching of incrementing or decrementing a cursor” and “Zeinstra teaching of acoustic messages.” (Examiner’s Answer, page 12, 3<sup>rd</sup> paragraph). This improper parsing of the “acoustic means” claim limitation does not meet the requirements of the 6<sup>th</sup> paragraph of 35 USC § 112 and therefore the Examiner’s failure to follow the statutory requirements is quite clearly reversible error.

The issue before the Board is not whether the prior art discloses the functions as alleged by the Examiner, but whether the Examiner has properly construed Appellant's "acoustic means" as set out in the claims and then indicated where the properly construed claim structure exists in the cited prior art. The Examiner's failure to properly construe the claims is reversible error and the Board's guidance in this regard is respectfully requested.

**B. The Examiner fails to identify any prior art reference disclosing any structure falling within the scope of the properly construed "acoustic means" in claim 1 (and similar structure and method step in claims 7 and 8) or its claimed structural interrelationship**

Appellant has alleged in the Appeal Brief that the Examiner fails to disclose Appellants' claimed "acoustic means." In the paragraph bridging pages 12 and 13 of the Examiner's Answer, the Examiner merely reiterates his conclusion that the Potter and Zeinstra references disclose the claimed limitation. The Examiner again suggests that Potter teaches "a cursor for selection options" with a "rotary switch control knob" for incrementing or decrementing the cursor. However, this does not take away from the Examiner's prior admission that Potter doesn't teach the claimed "acoustic means" set out in the previous Final Rejection and addressed on page 9 of the Appeal Brief.

The Examiner again argues that the Potter reference at column 10, lines 10-56 discloses functional features covered by Appellant's "acoustic means." Again, while Potter teaches a rotary switch control knob for incrementing and decrementing a cursor, there is no structure identified in Potter with "sending to the user an audible message

comprising a voiced representation of the option selected by the pointer.” If the Examiner believes otherwise, he is requested to now make that identification.

As clearly discussed in column 10, Potter relies upon “rotation of switch 22 will move a cursor to highlight a desired letter for entry into the phone list” as a manner of entering names and/or numbers into a telephone list. The Examiner does not allege that Potter provides any “audible message” or other audible indication which is a “representation of the option selected by the pointer.” Potter simply provides a visual representation for spelling out names and/or phone numbers into a telephone list. Thus, it is clear that the Examiner, even after reviewing the arguments in the Appeal Brief, continues to refuse to identify where there is any disclosure of Appellant’s claimed “acoustic means” set out in the Potter reference.

In the Appeal Brief in the first paragraph on page 10, Appellant again points out that the portion of the Zeinstra reference (cited by the Examiner, i.e., column 7, lines 16-35 and column 14, lines 8-18) merely teaches a conventional voice actuated control system. As stated in the Appeal Brief, “it is the user’s voice which provides the voice actuation.” (Page 10, line 4). However, the Examiner continues to fail to identify any portion of Zeinstra which sends to the user “an audible message comprising a voiced representation of the option selected by the pointer.” Should the Examiner now contend that this is disclosed in Zeinstra, he is requested to make that identification.

Absent such a disclosure, the Examiner continues to avoid meeting his burden of indicating where Appellant’s claimed structure is disclosed in either Potter or Zeinstra.

Finally, at the end of the first partial paragraph on page 13 of the Examiner's Answer, the Examiner, intentionally or unintentionally, misrepresents the admission by Appellant on page 10 of the December 9, 2009 Amendment. In discussing the Zeinstra reference at column 14, Appellant's Amendment specifically stated "if a voice command is given and that command is not understood by the system, there is an audible prompt which says 'did you say . . . ' which then allows the operator to respond 'yes' or 'no'."

However, the Amendment goes on to state that "while this does provide clarification of audible inputs made by a user (as is typical with voice actuated control systems), it does not provide any voice representation **of an option selected by the pointer.**" (Emphasis in original). The point made by the so-called "admission" is that Zeinstra does not provide any "voiced representation of the option **selected by the pointer** in response to said pointer being incremented or decremented" as required by Appellant's claimed "acoustic means." The Examiner apparently continues to ignore the point made in the previous Amendment and in the Appeal Brief, i.e., that the burden is on the Examiner to identify where the prior art teaches Appellant's claimed structures and instead relies only upon functional discussions in the prior art which do not disclose the structures recited in Appellant's claims.

Again, should the Examiner believe Appellant to have somehow misrepresented his position, the Examiner may file a Supplemental Examiner's Answer and end the controversy by identifying structures in either Potter or Zeinstra which provide "**a voiced representation of the option selected by the pointer.**" The fact that the Examiner refuses to do so is particularly telling with respect to the Examiner's position.

Absent the Examiner supplementing the Examiner's Answer to indicate where either Potter or Zeinstra contains any disclosure of structure covered by Appellant's "acoustic means" claim language pursuant to the provisions of the 6<sup>th</sup> paragraph of §112, the Examiner's Answer continues to be deficient with respect to meeting the requirements of 35 USC §103.

**C. The Examiner fails to meet his burden of setting evidence establishing a *prima facie* case of obviousness because no cited reference discloses the claimed "acoustic means"**

On page 13, the Examiner does not dispute that, as specified in the Appeal Brief, he has the burden of establishing a *prima facie* case of obviousness. The Examiner does not dispute that, in order to meet his burden, he must show that the prior art reference discloses the claimed structures and claimed structural interrelationships. The Examiner does not specifically dispute that he has failed to disclose any teaching of the claimed "acoustic means" or "sending to the user an audible message comprising a voiced representation of the option selected by the pointer."

The Examiner merely alleges, without any support, that the "above combination" (presumably Potter/Zeinstra) is believed to cover the claims. As a result, the Examiner does not dispute the Appeal Brief section C which confirms that the Examiner has failed to set out a *prima facie* case of obviousness.

**D. The Examiner fails to set out a *prima facie* case of obviousness because there is no required “analysis” of the Examiner’s reasons for combining references**

Appellant’s Appeal Brief section D points out the fact that the Examiner, in order to set out a *prima facie* case of obviousness, is also required to provide a “analysis” as to reasons motivating one of ordinary skill in the art to pick and choose elements from the Potter and Zeinstra references and then combine them in the manner of Appellant’s claims. Instead of providing the required analysis, the Examiner merely makes the statement that the Potter/Zeinstra combination “allows for an intuitive handsfree method for the user to confirm selection without taking their eyes off of the road” but does not indicate any structures comprising the claimed “acoustic means” for sending to the user an audible message comprising “a voiced representation of the option selected by the pointer in response to said pointer being incremented or decremented.”

Accordingly, the Examiner does not cure the deficiencies noted in the Appeal Brief regarding his burden of establishing a *prima facie* case of obviousness and any further rejection of the claims is respectfully traversed.

**E. The Examiner fails to meet his burden of establishing a *prima facie* case of obviousness with respect to claims 1-6**

On page 14 of the Examiner’s Answer, the Examiner responds to the allegations set out in the Appeal Brief by simply ignoring the statements made, i.e., the Examiner again concludes that “Appellant’s specification only defines the acoustic means as ‘means suitable for sending to the user an audible message constituting a voiced representation of the option selected by the pointer in response to said pointer being



incremented or decremented’.” Again, rather than identifying the structure in Appellant’s specification which corresponds to the “acoustic means” (as required by §112), the Examiner merely parses the functional language out to the disclosure in the Potter and Zeinstra references, neither of which discloses any “voiced representation of the option selected by the pointer.”

The Examiner simply fails to either set out a *prima facie* case of obviousness or indicate where such a *prima facie* case was set out in the Final Rejection.

**F. The Examiner fails to meet his burden of establishing a *prima facie* case of obviousness with respect to claims 7 and 8**

In failing to respond to section F of the Appeal Brief and the rejection of claims 7 and 8, the Examiner’s Answer again merely restates the Examiner’s conclusory statement that the Potter and Zeinstra references disclose functions which are set out in Appellant’s independent claims and thereby avoids the clear contradiction of 35 USC §112 and the Examiner’s obligations for properly construing the “acoustic means” claim language.

**CONCLUSION**

Appellant has again pointed out that the Examiner fails to properly construe the “acoustic means” language in the independent claims in accordance with the statutory requirement of 35 USC §112 (6<sup>th</sup> paragraph). Having failed to properly construe the claim, the Examiner then fails to identify the properly construed structure of the claims as being present in any prior art reference. The Examiner continues to misstate what is required by Appellant’s claims, i.e., “means suitable for sending to the user” rather than the actual claim language of “acoustic means for sending to the user . . . .” Appellant has

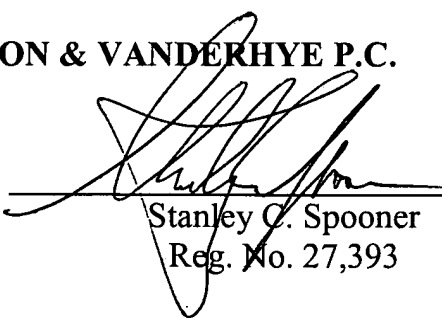
repeatedly identified the actual claim language, i.e., “an audible message comprising a voiced representation of the option selected by the pointer” and has noted that nowhere in the Examiner’s Answer does the Examiner indicate where either prior art reference discloses a “voiced representation of the option selected by the pointer.” One would think that if this were disclosed in the prior art, the Examiner would identify this structure. Appellant has also pointed out the other deficiencies in the Examiner’s obviousness rejection and these are similarly ignored in the Examiner’s Answer.

As a result of the above, the Examiner has simply failed to properly construe the claims and failed to properly identify any structure in the cited prior art which meets the claim language. Thus, and in view of the above, the rejection of claims 1-8 under 35 USC §103 is clearly in error and reversible thereof by this Honorable Board is respectfully requested.

Respectfully submitted,

**NIXON & VANDERHYE P.C.**

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